

REMARKS

Status of the Claims

Claims 1-16, 18-21, 23-29, and 40-51 are pending and claims 18, 20-21, 23-29, and 40-51 are under consideration, claims 1-17, 19, 25, and 30-39 having been withdrawn for allegedly being drawn to separate inventions.

Applicants respectfully request that the amendments made herein be admitted. The amendments to claims 41 and 48 are made to comply with the Examiner's request for clarification and those to claims 18, 41, and 48 to put them in a form that the Examiner indicates would be allowable. New claims 52-56 correspond to previously presented claims 19-21 and 40 but are dependent on claims 41 and/or 48 (rather than claim 18).

Should the amendments made herein be entered, claims 1-16, 18-21, 26-29, 40-44, 48, and 52-56 will be pending and claims 18-21, 26-29, 40-44, 48, and 52-56 will be under consideration in this application, claims 23-25, 45-47, and 49-51 having been cancelled without prejudice to their being presented in a separate application and claims 52-56 having been newly added. New claims 52-54 and new claims 55 and 56 are supported by the specification (e.g., at page 2, lines 11-20; and page 32, lines 28-33, and page 33, line 32, to page 34, line 3, respectively) and add no new matter.

35 U.S.C. § 112, second paragraph, rejection

Claims 41 and 48 stand rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention.

In that the last lines of claims 41 and 48 specify species (a method of killing a target cell" and "an imaging method", respectively) of the embodiment recited in the preamble of both claims ("A method of delivering a radiolabeled immunotoxin to a subject suspected of having cancer"), Applicants respectfully submit that the claims are clear. Nevertheless, in order to expedite prosecution of the instant application, the preambles of the claims have been amended to recite the embodiments of the last lines and the last lines have been canceled. These amendments add no new matter.

Applicants respectfully submit that, in light of the above amendments, the rejection is moot.

35 U.S.C. § 103(a) rejection

Claims 18, 20, 21, 23, 26-29, 40, 41, 43-54, 48, and 49 stand rejected as allegedly being unpatentable over U.S. Patent No. 5,990,296 (the '296 patent) in view of the U.S. Patent No. 5,332,567 (the '567 patent) and further in view of U.S. Patent Application Publication No. 2002/0095044 (the '044 application) and U.S. Patent No. 5,476,866 (the '866 patent).

From the comments on page 4, line 10, to page 6, line 21, of the Office Action, Applicants understand the Examiner's position to be that the above-listed claims are rendered obvious by the combined teachings of the '296 patent, the '567 patent, the '044 application, and the '866 patent. Applicants maintain their position that neither the '296 patent nor the '567 patent contain the necessary motivation to one ordinarily skilled in the art to combine their respective disclosures and hence to practice the methods of the rejected claims. Moreover, Applicants respectfully submit that neither of newly cited references (the '044 application and the '866 patent) remedy this defect in the '296 and '567 patents. Nevertheless, in order to expedite prosecution of the instant application, Applicants have amended claims 18, 41, and 48 by incorporating the limitations of claims 24, 46, and 50, respectively, which the Examiner indicated would be allowable if rewritten in independent form incorporating all the limitations of the base claims and any intervening claims (Office Action, page 7, lines 2-4); there are no intervening claims and thus incorporating the limitations of claims 24, 46, and 50 into claims 18, 41, and 48 results in the same claims as rewriting claims 24, 46, and 50 to be in independent form.

In that such claims would be allowable, Applicants understand that previously presented claims 20, 21, 26-29, 40, and 42-44 and new claims 52-56 would also be allowable. Moreover, Applicants believe that, in so far as claims 18, 41, and 48 with the limitations of claims 24, 46, and 50 incorporated are allowable, withdrawn species claim 19 would also be allowable.

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In light of the above considerations, Applicants respectfully request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

Examiner's Comments/Notes

With respect to the comments on page 7, lines 11-20, of the Office Action, Applicants respectfully submit that the normal animals Vallera et al. injected with radiolabeled immunotoxin merely for the purpose of studying the pharmacokinetics of the injected immunotoxin could not reasonably be construed as being “suspected of having cancer”, even applying the broadest construction of the plain and ordinary meaning of the word “suspected”.

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CONCLUSION

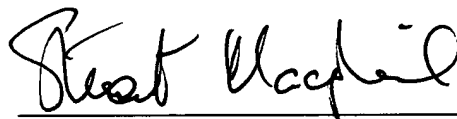
In summary, for the reasons set forth above, Applicants maintain that the pending claims patentably define the invention. Applicants request that the Examiner reconsider the rejections as set forth in the Office Action, and permit the pending claims to pass to allowance.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' undersigned representative can be reached at the telephone number listed below.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 09531-023001

Respectfully submitted,

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